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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,090	04/11/2005	Rami-Raimund Awad	11885-00062-US	2706

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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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10/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,090

Applicant(s)

AWAD ET AL.

Examiner

Michael J. Feely

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Pending Claims

Claims 1-13 are pending.

Response to Amendment

1. The rejection of claims 1-13 under 35 U.S.C. 112, second paragraph (*see section 3 of the previous Office action*), has been overcome by amendment.
2. The rejection of claims 2, 3, 6, 7, 9, and 11 under 35 U.S.C. 112, second paragraph (*see section 4 of the previous Office action*), has been overcome by amendment.
3. The rejection of claim 9 under 35 U.S.C. 112, second paragraph (*see section 5 of the previous Office action*), has been overcome by amendment.
4. The rejection of claim 8 under 35 U.S.C. 112, second paragraph (*see section 6 of the previous Office action*), has been overcome by amendment.
5. The rejection of claims 1-13 under 35 U.S.C. 112, first paragraph (*see section 8 of the previous Office action*), has been overcome by amendment.
6. The rejection of claims 2, 3, 6, 7, 9, and 11 under 35 U.S.C. 112, first paragraph (*see section 9 of the previous Office action*), has been overcome by amendment.
7. The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Budde et al. (US Pat. No. 5,629,374) has been overcome by amendment.

Claim Rejections - 35 USC § 112, 2nd paragraph

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

Applicant has amended claim 1 such that **ABC** is a mixture of adducts of **A** and **B**, with **C**. In other words, **ABC** is a mixture of (1) an adduct of **A** with **C** and (2) an adduct of **B** with **C**. However, it should be noted that the claim ends with the following limitation: “and that at least 50% of all reaction products derived from the epoxy resins **A** and **B** comprise at least one ester group formed by reaction of a terminal epoxy group with an olefinically unsaturated acid **C**.” In light of the new language, it is unclear how this limitation can be anything other than 100%. However, the new claim language, in concert with this previous limitation, suggests that **A** and **B** either react with each other or react with a reactant other than **C**. In light of this, the chemical nature of the reaction products in **ABC** is unclear. The specification also fails to clarify how this closing limitation is reflected in or influences the chemical nature of the reaction products in **ABC**.

For the purpose of the prior art search, the claim has been interpreted to read: “and that all reaction products derived from the epoxy resins **A** and **B** comprise at least one ester group formed by reaction of a terminal epoxy group with an olefinically unsaturated acid **C**.”

Claim Objections

10. Claims 9-11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *should refer to other claims in the alternative only*. See MPEP § 608.01(n). Accordingly, the claims 9-11 have not been further treated on the merits.

Claim 9 refers to the composition of claim 2 and the process of claim 8. Claim 10 refers to the composition of claim 4 and the process of claim 8. Claim 11 refers to the composition of claim 6 and the process of claim 9. This is a shift from the claim language featured in the preliminary amendment, wherein: claim 9 was dependent from claim 2; claim 10 was dependent from claim 4; and claim 11 was dependent from claim 6.

Allowable Subject Matter

11. Claims 1-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The indicated allowability is based on the following claim interpretation: "and that all reaction products derived from the epoxy resins **A** and **B** comprise at least one ester group formed by reaction of a terminal epoxy group with an olefinically unsaturated acid **C**."

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is (571)272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Feely/
Primary Examiner, Art Unit 1796

October 26, 2008